

*Appl'n. No. 08/941,174
Amdt. Dated May 19, 2003
Reply to Office Action of Feb. 19, 2003*

REMARKS/ARGUMENTS

Claims 5, 8-12 and 17-24 are pending for consideration. Claim 8 has been amended and claim 24 is a new claim.

Claim 8 has been amended to correct a typographical error and for clarification of the claimed subject matter.

Rejections Under 35 US 103

Claims 5, 8-12 and 17-22 have been rejected as unpatentable over Gateway 2000 Press Release, 08/21/96 (Gateway 2000 Press Release), in view of US Patent 5,191,423 (Yoshida), in view of "How to Use Microsoft Windows NT4 Workstation, Jacquelyn Gavron and Joseph Moran, Ziff-Davis Press, 1996 (Gavron). The rejection is respectfully traversed.

(A copy of the Gateway 2000 Press Release in the undersigned attorney's file record of this application accompanies this paper for verification by the Examiner because of difficulties in correlating comments in the Office Action with this reference. It is also noted that there are two other earlier cited internet articles "The Big-Tube PCTV", 08/21/96, Ziff-Davis and "Destination Features", 08/21/96, Gateway 2000 Inc." It is unclear whether or not these additional internet articles are relied on in the Office Action.)

The inadequacy of the set of references relied on is conceded by what appear to be mischaracterizations or assertions in the Office Action that various features are "(well) known in the art". For example, with respect to Gateway 2000 Press Release, it is asserted in the Office Action *"The Gateway 2000 PCTV necessarily enables the user to place the system in one of a PC or TV mode."* And then *"[The disclosure] . . . teaches that at least Windows 95 may be pre-installed on the PCTV."* Whereas in the copy of the Gateway Press Release in the possession of Applicants' attorney, no such disclosure is seen. (Such a reference does occur in an earlier cited Internet article "The Big-Tube PCTV", May 28, 1996.) . And, *"It was known that Windows 95 included the Microsoft Internet Explorer, IE4 package. The Internet Explorer, IE4 comprises*

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multiple pre-loaded URL's at least to the Microsoft web site." "Official Notice is taken that . . . it was well known to store EPG within a TV-computing device." (But in relation to claim 9 it is asserted in the Office Action ". . . page 3 of Gateway 2000 Press Release teaches downloading an EPG. " – no specific disclosure is seen on page 3 but page 3 of "Destination Features" includes the statement: "Subscribe: Option to subscribe to the TV Guide on-line service". The stated grounds of rejection of claims 8 and 9 are thus unclear.) Consequently, this ground of rejection should be withdrawn or the source of each of the features asserted in the Office Action as present in Gateway 2000 Press Release should be clarified so that a properly informed evaluation of and response to these grounds of rejection can be made.

Beyond that, the necessity in the Office Action to supplement the disclosures of at least three disparate references with assertions that several still missing features were "known" or "well known" exposes the inadequacy of the rejections to state a *prima facie* case of obviousness. With respect, the Examiner is reminded of the necessity, to establish a *prima facie* case of obviousness, to make an objective factual showing that the combination of prior art references relied on not only includes all of the claimed elements, but also a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention considered as a whole to have been obvious in the light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985) See MPEP 2142. In determining the differences between the prior art and the claims, the question under 35 US 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 2d 871 (Fed. Cir. 1983); *Schenk v. Nortron Corp.*, 218 USPQ 698 (Fed. Cir. 1983) See MPEP 2141.02. Even if the cited references were to disclose (which as discussed above, they do not) that all elements of the claimed invention were individually known in the art, that is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pt. App. & Inter. 1993); *In re Kozab*, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). The level of ordinary skill in the art cannot be relied upon to provide the suggestion to combine references. See MPEP 2143.01. Yet that is precisely what has been relied on in each of the three paragraphs in Section 4 of the Office Action applying Gateway 2000 Press Release against claim 8, and by implication against claims 8-12 and 17-23.

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The rejection of claims 5, 8-12 and 17-23 should be withdrawn on this basis alone.

Yoshida's disclosure does not extend beyond presenting a user with a list of names of broadcasting stations based solely on user input of an initial letter of a broadcasting station (col. 1, line 55 to col. 2, line 6). Yoshida teaches that when a list of channel names having a particular initial letter is displayed, user operation of a "CH" key is required to move a cursor from the first displayed name to the next, and so on until a desired channel is selected. When 5 seconds have passed without the "CH" key being pressed for channel up, the channel is fixed, and the operation is completed. The Office Action recognizes Yoshida *"only teaches entering the first alphanumeric key actuation"*, and speculates, subjectively, *"...one of ordinary skill in the art would have been motivated to sort a list of stations using more than just the first alphabet (sic), at least in order to provide the user with a more narrow search."* No such suggestion or motivation is provided by Yoshida and, again, the Office Action appears impermissibly to rely on the level of skill in the art to provide a subjective and speculative conclusion that Yoshida could have been combined with Gavron in attempt to remedy the admitted shortcomings of Yoshida. In one mode (Item 3 cited in the Office Action) Gavron teaches: "To search for information by topic click on the Index tab, which displays an index like the one at the back of a book. In the blank space at the top of the dialog box, type in either the entire word or just the first few letters of the word you are interested in. As soon as you start typing, the Index list jumps to that topic." (The Office Action asserts *"...since the user entered the word, 'folders' at least two entries are listed that include that instant sequence of alphabets (sic)."* Such disclosure is not apparent from the copy of this reference available to the undersigned attorney. If this reference is to be relied on, receipt of a reasonable quality enlarged version of at least the portions of page 7 being relied on would be appreciated.) Reference in Gavron to "folders" is seen in Items 5 and 6 of Gavron, directed to locating information in an extensive database providing "HELP" support for a Windows NT4 Workstation and which initially requires user identification of one of a plurality of access modes, one of which is a word search mode ("Find") "which generates a list of *all* words in the entire help system." (Gavron, Item 5; emphasis in original.) Gavron continues "Now just type the word (or words) that best describes what you need help with - in this example it's folders." (Gavron, Item 6.) Items 5 and 6 on their face are not seen to be pertinent to the claimed invention. Nor is it clear how the Office Action proposes

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that Gavron Item 3 be utilized in conjunction with Yoshida. Yoshida is not concerned with "topics" and does not provide a "topical index" which is the starting point for Gavron's search activity in Item 3. Nor does the Office Action provide any objective, fact based evidence as to how Yoshida or Gavron suggest that Gavron might be modified to adapt to Yoshida without adversely affecting Gavron's suitability for its intended purpose, as described at Item 3. No support is seen in Yoshida or Gavron for arbitrary selection in the Office Action of an isolated feature from Gavron, although such motivation may be apparent from applicant's claimed invention – but that is an impermissible hindsight basis for identifying motivation.

Withdrawal of the rejection of claims 5, 8, 12 and 17-22 on the basis of Gateway 2000 Press Release, Yoshida, Gavron together with various individual elements asserted to have been within the knowledge of a person of ordinary skill in the art is respectfully requested as failing to establish a *prima facie* case of obviousness.

The rejections of claims 10, 11 and 12 again rely on assertions of "obviousness" impermissibly based on the individual items being "well known" in the art, and are traversed for the same reasons discussed above in respect of this type of rejection. The pertinent consideration is to be directed to the invention considered as a whole – i.e. the element(s) set forth in claims 10, 11 and 12 each considered in combination with all of the features of claim 8.

In the rejection of claim 20 is stated "... the claimed features of a computer system emulating a TV system which corresponds with subject matter of claim 8, are likewise analyzed." With respect, while claim 20 includes recitation explicitly directed to "channel macros", claim 8 does not include similar explicit recitation. Consequently, the grounds rejection of claim 20 are respectfully traversed as incomplete as well as for similar reasons advanced in respect of claim 8.

In rejecting claim 23, yet a further reference – US Patent 6,202,212 (Sturgeon) has been added to Gateway Press Release, Yoshida and Gavron and the various assertions that additional individual features of the claims not disclosed by the references were (well) known in the art, and correlated with speculation of "obviousness" based on a "desirable benefit of presenting the

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viewer with an unencumbered view of the TV program" but no support of suggestion or motivation in the prior art. Claim 23 has been rejected based on assertions that individual differences between elements of the claimed combination and individual references would have been "obvious" whereas, as discussed in detail in relation to the rejection of claim 8, the question under 35 US 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious, and no objective, fact based evidence has been presented in the Office Action in that respect.

New claim 24 develops the subject matter set forth in claims 8 and 19 and is patentable for at least similar reasons set forth above in respect of those claims.

In summary, it has been shown in the above discussion that the grounds of rejection set forth in the Office Action fail to meet the criteria set forth in MPEP 2143 necessary to establish *prima facie* case of obviousness. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure. In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991) – see MPEP 2143 (emphasis added). With respect, the grounds of rejection as advanced in the Office Action fail to satisfy this standard.

Favorable consideration and early allowance of the application are solicited. If telephone discussion of any matter might assist expediting prosecution of this application, a telephone call to the undersigned attorney at 972-862-7428 would be appreciated.

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FOR IMMEDIATE RELEASE

Gateway 2000 Sells Destination™ Big Screen PC Through Retail Chains

*New retail distribution strategy lets consumers experience
breakthrough PC*

NEW YORK CITY, August 20, 1996 - Gateway 2000, the nation's leading direct marketer of personal computers, today announced it will make its breakthrough Destination big-screen PC available through select retail stores, in response to consumer demand.

"When people see Destination they want it," said Gateway 2000 Chairman and CEO Ted Waitt. "To explain this new category of convergence technology, we need to allow people to experience Destination. A retail partnership is the most efficient way to get Destination into the hands of these interested consumers. That's why we're expanding our definition of direct marketing for this product. By allowing people to touch and feel Destination near their homes, they can appreciate how different and useful the system really is."

Destination will be the only Gateway product sold through retail chains.

The system represents a new category of PCs that for the first time combines the impact of high-quality, big-screen television with the intelligence of a computer. Destination will be available at all Nobody Beats the Wiz stores on the East Coast and select CompUSA Computer SuperstoresSM throughout the U.S. It will also continue to be available through direct-mail by calling Gateway. Destination will be available in Nobody Beats the Wiz stores this week, and in CompUSA stores by mid-September.

"Destination has generated more interest than any other single product Gateway has ever introduced," said Waitt. "We created a new category of technology and successfully sold Destination to our traditional customer base, the leading-edge computer users. Now, as part of our ongoing effort to demystify this new convergence system, we want to give consumers the opportunity to experience Destination -- and see how it revolutionizes the way people use television, computers and the Internet."

The system, which offers video images superior to those of television, is the first product to offer the full functionality and features of both consumer electronics and computers. Gateway holds and is applying for more than 20 patents on the Destination big screen PC. The system was developed in partnership with several companies over the last two years.

"Our customers want revolutionary products and we're thrilled to be able to offer Destination by Gateway 2000 in our stores," said Nobody Beats the Wiz President, CEO and Co-Founder Lawrence Jemal.

"Destination offers consumers more choices than traditional single-function consumer electronic devices, and can be upgraded as technology changes. It's perfect for consumers who want to keep up with the changes taking place in broadcast and computer technology."

Jim Halpin, President and CEO of CompUSA Inc., said, "Destination brings together the power of consumer electronics and computers. It turns the family living room into a gateway to the world ... through the TV, the Internet and by taking advantage of the exciting new multimedia software available today."

Gateway is also expanding consumer access to Destination by placing the system in public locations, including Epcot Center in Orlando, Fla.; Computer Life's Cyber Home of the Future near Los Angeles, Calif., and the Otherside, a unique video arcade based on Destination technology that is located near Seattle, Wash.

The Destination system was developed following extensive research to determine what consumers want from technology. The research showed that consumers want technology that allows people to share the experience.

Unlike current personal computers, which require people to huddle around a small monitor, the Pentium processor-based Destination system is designed to let users spread out 10 to 15 feet from its 31-inch screen. The computer and television functions are controlled through a touchpad-equipped wireless keyboard and a wireless Field MouseTM remote control/mouse.

The system is compatible with consumer electronics components such as VCRs, stereo systems, and laser disc players. Destination can take video feeds from cable television systems, traditional antennas or other video devices. Audio signals from the Destination system can be channeled through home stereo systems to offer surround sound capability.

Stephen M. Baker, senior analyst for distribution channels research at IDC, said: "In CompUSA and Nobody Beats the Wiz, Gateway 2000 has chosen two chains with dominant positions in their markets, ones whose employees have the skill set to properly market and sell the product in a retail setting.

"In addition, both run the type of efficient, customer-focused operations that Gateway itself practices" he said. "These two chains add strong, stand-alone brand names to help build the appeal of Destination."

Retail prices for the Destination big-screen PC will begin at \$3,999 depending on configuration. Retailers' inventories will be refreshed frequently to make sure every system incorporates the latest technology.

Customers can also place orders for custom-configured systems by calling Gateway directly at (800) 846-2000. Any customers who want

to see Destination can call Gateway and will be referred to the closest CompUSA or Nobody Beats the Wiz store location. The Gateway 2000 build-to-order capability lets customers specify what they want on their systems. Gateway offers a wide selection of software, service and hardware upgrades, including faster processors, additional memory, larger hard drives, and faster CD-ROM drives.

They can also get more information from the Gateway 2000 Internet site at <http://www.gw2k.com/destination>.

About Gateway 2000

Gateway 2000, a Fortune 500 company founded in 1985 and based in North Sioux City, S.D., sells more PC-compatible systems through the direct market channel in the U.S. than any other PC manufacturer. Gateway products and services consistently win top awards from leading industry publications, and independent surveys show that Gateway customers are among the most satisfied and brand-loyal PC buyers. The company's 1995 sales were \$3.7 billion. Gateway 2000 is listed on the NASDAQ market as GATE.

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